



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/566,377	01/26/2006	Michael Bachenberg	5054.1002	2087
7278 7590 12/04/2008 DARBY & DARBY P.C. P.O. BOX 770 Church Street Station New York, NY 10008-0770				
EXAMINER KAMPURIA, SHARAD K				
ART UNIT 2617		PAPER NUMBER		
MAIL DATE 12/04/2008		DELIVERY MODE PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/566,377

Applicant(s)

BACHENBERG, MICHAEL

Examiner

SHARAD RAMPURIA

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 August 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 40-63 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 40-63 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 August 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 62-63 are rejected under 35 U.S.C. 101, because of non-statutory as describe following:

Regarding claims 62-63, it is clearly calls for “a software product” comprising “code means”

As best can be support by the specification (§ 0144), “a software product” is actually “a software/computer program” which does not fall within any of the enumerated statutory categories because it is an Abstract Idea, *and the invention as claimed does not produce a useful, concrete, and tangible result*. Therefore, claims 62-63 are nonstatutory. (Please see MPEP 2106.01 [R-6]).

Claim Rejections - 35 USC § 112

The following is a quotation of the **first** paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 62-63 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the **written description requirement**. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claims 62-63, the amended limitation, "A computer readable medium." The applicant's specification fails to support such limitation.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 40-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over **OWENSBY, CRAIG A.** [US 20020077130 A1] in view of **Chern; Vincent et al.** [US 6381465 B1].

As per claim 40, **OWENSBY** teaches:

A method for a transmission of additional information in a communication system (Abstract), comprising the steps of:

establishing a communication context between a first user station to at least one second user station for transmitting data from the first user station to the second user station, the context allowing additional information to be transmittable from an additional information device to the second user station; (§ 0029, 0043)

transmitting the addition information for display on the second user station based on the processing of the response signal. (§ 0029, 0010, 0043)

OWENSBY doesn't teach specifically, the response signal to determine whether the second user station is ready to receive the additional information. However, **Chern** teaches in an analogous art, that sending query data from the additional information device to the second user station; receiving a response signal associated with the second user station generated in response to the query data, the response signal indicating whether the second user station is ready to receive the addition information; processing the response signal to determine whether the second user station is ready to receive the additional information. (e.g. status; Col.15; 44-54) Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to including the response signal to determine whether the second user station is ready to receive the additional

information in order to provide a method for attaching an advertisement or coupon to an SMS message for wireless transmission.

As per claim 41, **OWENSBY** teaches all the particulars of the claim except a clearance for the receipt of additional information during subsequent communication connections. However, **Chern** teaches in an analogous art, that the method as recited in claim 40, the response signal from the second user station includes a clearance for the receipt of additional information during subsequent communication connections. [e.g. status; Col.15; 44-54]

As per claim 42, **OWENSBY** teaches:

The method as recited in claim 40, further comprising the steps of: including at least one of the data and the additional information in a predefined format in a set-up signal configured for establishing the communication context; and transmitting the set-up signal to the second user station including the at least one of the data and the additional information, wherein the predefined format permits the at least one of the data and the additional information to be represented as a data card having at least one of text and image content before the communication context is established. (¶ 0029, 0043)

Claims 43-46, 49 are the **method** claims, corresponding to **method** claim 42 respectively, and rejected under the same rational set forth in connection with the rejection of claim 42 respectively, above.

As per claim 47, **OWENSBY** teaches:

The method as recited in claim 40, further comprising the steps of:

sending the query data to the first user station, the query data including a plurality of additional information models; selecting at least one of the plurality of additional information models at the first user station; and generating a response signal associated with the first user station indicating the selected at least one additional information. (§ 0029, 0043)

As per claim 48, **OWENSBY** teaches:

The method as recited in claim 47, wherein at least one of the plurality of additional information models is linked to a field for entering subject information at the first user station. (§ 0029, 0043)

As per claim 50, **OWENSBY** teaches:

The method as recited in claim 40, further comprising the steps of:

evaluating the response signal to determine a charge reduction data, wherein the communication context has an associated cost, and wherein the charge reduction data includes at least one of a reduced cost for the communication context and a improved communication context. (§ 0029, 0043)

Claims 51-58 are the **system** claims, corresponding to **method** claims 41-46 respectively, and rejected under the same rational set forth in connection with the rejection of claims 41-46 respectively, above.

Claims 59-60 are the **apparatus** claims, corresponding to **method** claims 41-42 respectively, and rejected under the same rational set forth in connection with the rejection of claims 41-42 respectively, above.

Claim 61 the **method** claim, corresponding to **method** claim 41 respectively, and rejected under the same rational set forth in connection with the rejection of claim 41 respectively, above.

Claims 62-63 are the **computer readable medium** claims, corresponding to **method** claims 41-42 respectively, and rejected under the same rational set forth in connection with the rejection of claims 41-42 respectively, above.

Response to Amendments & Remarks

Applicant's arguments with respect to claims 40-63, have been fully considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment (For illustration; since newly amended claims modified the above-disclosed rejection) necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharad Rampuria whose telephone number is (571) 272-7870. The examiner can normally be reached on M-F. (8:30-5 EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dwayne Bost can be reached on (571) 272-7023. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000 or

EBC@uspto.gov.

/Sharad Rampuria/
Primary Examiner
Art Unit 2617